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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,508	12/26/2000	Robert H. Willis	BS99-184	9790

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EXAMINER

KRAMER, JAMES A

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/746,508	Applicant(s) WILLIS ET AL.	
	Examiner James A. Kramer	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,5,7,10,11 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,5,7,10,11 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/25/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgments

In light of the fact that Examiner has entered new grounds of rejection in this Office Action (i.e. claims are rejected under 35 USC 112 first paragraph) this Office action is being made non-final to afford Applicant an opportunity to address this rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 4, 5, 7, 10, 11, 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Focusing on independent claim 20, which recites the following limitation, “receiving, via a communications network, information sent by the technician, upon diagnosing a malfunction at the first subscriber location having a first line number, wherein the information is provided in an electronic format and identifies a cause of the malfunction underlying one of the reports of malfunctions sent from a vicinity of the first subscriber location and wherein the cause is at a location other than the first subscriber location...” (note underlined section).

Examiner notes that this limitation requires the technician at the first subscriber location to identify the cause of the malfunctions at other locations. This is not Applicant’s disclosed

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invention, nor would one of ordinary skill in the art have believed that Applicant was in possession of such an invention at the time of filing.

Applicant describes the role of the first technician in the Specification on page 12, lines 10-16 and the paragraph bridging pages 13 and 14. Specifically, the only information received from the first technician, according to the Specification, identifies “that there are no problems with the network resources used by the customers in the first” dwelling.

Further, based on Applicant’s Specification, the disclosed present invention relies on the dispatch division (not technicians) to “consider other resources or assets of network 300 that could be causing the problems experienced by the customers.” (see page 14, lines 4-7) Further the dispatch division requires information from a plurality of technicians to determine “the likely problem” (see page 14, lines 8-15).

It is the position of the Examiner, that not only does the first technician of Applicant’s disclosure not identify the cause of the malfunction, but the first technician does not have the resource, information or capabilities (evidenced by the fact that the dispatch division requires information from more than one technician to determine the likely cause) to make this identification. As such one of ordinary skill in the art at the time of the present invention would have to conclude that Applicant was not in possession of the claimed invention at the time of filing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5, 7, 10, 11, 20-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Pruett et al.

Pruett et al. teaches a combination system for provisioning and maintaining telephonic network facilities in a public switched telephone network. Pruett et al. specifically teaches a Caseworker obtaining a description of a customer trouble (column 40; lines 47-49). With this information the Caseworker builds a trouble report profile which is forwarded to Dispatch (column 42; lines 51-53) where a technician is sent. Examiner notes that this relates to applicant's receiving reports or malfunctions and dispatching technicians in response to the reports.

Pruett et al. further teaches that the field technician determines any related trouble reports stored in Dispatch. The field technician closes out the Trouble Report by entering the trouble found, work done and cause descriptions (column 43; lines 41-45). Examiner notes that this represents receiving, via a communications network, information sent by the technician upon diagnosing a malfunction at a first subscriber location, wherein the information is provided in an electronic format, and identifies a cause of the malfunction underlying one of the reports of malfunction sent from the vicinity of the first subscriber location.

Pruett et al. further teaches that the reactive maintenance system is able to collate and group related reactive and proactive troubles, as well as determine whether technicians are currently working on a recently reported reactive trouble (e.g. column 53; lines 12-15). This has the additional benefit of allowing caseworkers to determine that a trouble from a customer is already being worked (e.g. column 40; lines 62-67). Examiner notes that this relates to determining, by the dispatch division (Caseworker) and based upon information sent by the technician upon diagnosing the malfunction at the first subscriber location, that a cause underlying another report, received from a location different from the first subscriber location is the same cause as the first location.

Pruett et al. also teaches information recorded by the caseworker or the field technician is automatically sent to other systems as needed. For example time and materials charges are sent to a billing function (col. 43, lines 55-57).

Pruett et al. is silent as to who receives the billing from the Billing Function.

The common knowledge or well-known in the art statement made by the Examiner in the Office Action mailed 5/12/05 is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or the traverse was inadequate (MPEP2144.03(C)).

Examiner relies on the Admitted Prior art that it is old and well known for a responsible party to be billed for all costs incurred, even indirectly. As way of example, Examiner offers that in a car accident, the responsible party is billed not only for the car they hit, but also for any other damages that are incurred as a result of the accident (i.e. other cars hit, injuries etc).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the billing function of Pruett to bill the responsible party for all costs incurred as a result of their negligence including any service calls made in response to that damage. One of ordinary skill would have been motivated to modify the reference in order to recover all costs caused by the responsible party.

Response to Arguments

Applicant argues that there is no teaching in Pruett which teaches that “costs associated with the discrete diagnosis are grouped together for a common cause in order to bill a responsible party.”

Examiner addresses this argument by pointing out that the discrete diagnosis are in fact grouped together by Pruett in order to identify the underlying cause. However, Examiner agrees that the costs associated with this grouping are never put together in order to bill a responsible party. However, this is exactly why the Examiner has rejected the claims under 35 USC 103 as obvious in view of Pruett, rather than anticipated by Pruett under 35 USC 102.

Applicant further asserts that there is no reason to adopt a concept from a non-analogous industry (insurance). Examiner respectfully reminds Applicant that one of the criteria for analogous art is the problem being solved. The insurance example provided by the Examiner solves the same problem as the present invention (e.g. billing a responsible party) See MPEP 2141.01(a). Further Applicant even address the relation between an insurance company and the present invention on the paragraph bridging pages 16 and 17 of the specification.

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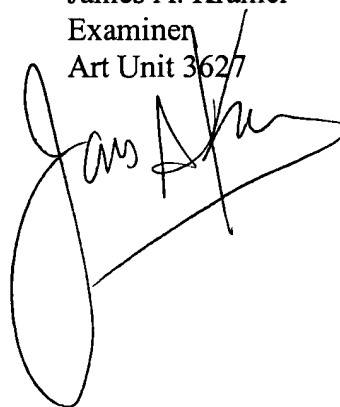
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783.

The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272 6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Kramer
Examiner
Art Unit 3627

A handwritten signature in black ink, appearing to read 'James A. Kramer', is written over the printed name and title.

jak
9/7/06